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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,890	10/12/2001	Prathima Agrawal	APP 1299-US	9688

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EXAMINER	
PARK, JUNG H	

ART UNIT	PAPER NUMBER
2661	

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/975,890	AGRAWAL ET AL.	
	Examiner	Art Unit	
	Jung Park	2661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-22 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-22 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 09/975,910 (hereinafter, "the '910 application"). This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. Although the conflicting claims are not identical, they are not patentably distinct from each other because;

Regarding claim 1, the broader claim would have been obvious in view of the narrower issued claim. Claim 1 of the '910 application recites the limitations, "storing a shadow address in the first base station and the second base station", "transmitting a frame containing the packet", and "processing the frame received from either the first base station or the second base station in the mobile station". On the other hand, claim 1 of the instant application recites the limitations, "storing a shadow address in the base station" and "transmitting the packet". Therefore, claim 1 of the instant application merely broadens the scope of claim 1 of the '910 application by eliminating the limitations, "the second base station", "a frame containing", and "processing the frame received from either the first base station or the second base station in the mobile station". Therefore, it would have been obvious to one of ordinary skill in the art that if packets are not transmitted in a frame, there is no need to process the frame. It has been held that the omission an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd.App.1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

Regarding claim 2, it is claim corresponding to claims 1 and 2 of the '910 application and is therefore rejected with the reason of the provisional rejection based on a nonstatutory double patenting ground.

Regarding claims 3, 4, 5, 6, 7, 8, 9, 11, 12, and 13, they are claims respectively corresponding to claims 3, 4, 5, 8, 9, 12, 13, 8, 12, and 13 of the '910 application and are therefore rejected with the reason of the provisional rejection based on a nonstatutory double patenting ground.

Regarding claim 10, it is claim corresponding to claims 8 and 9 of the '910 application and is therefore rejected with the reason of the provisional rejection based on a nonstatutory double patenting ground.

Regarding claim 14, it is claim corresponding to claims 8 and 12 of the '910 application and is therefore rejected with the reason of the provisional rejection based on a nonstatutory double patenting ground.

3. Claims 19-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 13 and 19 of copending Application No. 09/975,801 (hereinafter, "the '801 application"). This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. Although the conflicting claims are not identical, they are not patentably distinct from each other because;

Regarding claim 19, the instant application merely broadens the scope of the claim 19 of the '801 application. The broader application claims would have been obvious in view of the narrower issued claims (see *In re Emert*, 124 F.3d 1458, 44 USPQ2d 1149).

Regarding claims 20, 21 and 22, they are claims corresponding to claim 13 of the '801 application and are therefore rejected for the similar reasons set forth in the rejection of claim 19.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 15-18 are rejected under 35 U.S.C. 102(b) as being unpatentable over the Bantz et al. (U.S. 5,519,706, hereinafter "Bantz").

Regarding claim 15, Bantz discloses the method for communication comprising: storing a shadow address in the base station (col. 7, lines 43), the shadow address serving as a unique identifier of the mobile station (*MAC address of a mobile* col. 7, lines 52-53); examining, at the base station (*looks up in its cell members* col. 10, line 39), each packet received to determine if the shadow address of the packet matches one of the stored shadow addresses (col. 10, lines 39-42); and communicating from the base station, each examined packet for which there is a match to the appropriate mobile station (*sends a registration response* col. 10, lines 49-50).

Regarding claim 16, Bantz fails to teach the decapsulation of IP packets, however, it is inherent that propagating a packet from a base station to a mobile station includes removing a packet from the wireline frame, passing the packet to the IP layer of the base station, encapsulating the packet as a link layer wireline frame, and propagating the link layer wireless frame over a radio channel coupling the base station with the mobile station. This is the way of communication in wireless LAN that wireless base stations are wired to an Ethernet network and transmit a radio frequency over an area of sever hundred feet.

Regarding claim 17, the step of switching each examined packet (*registration request and response* col. 10, lines 6-67 and col. 11, line 1) for which there is a match to the base station radio interface channel corresponding to the mobile station (col. 8, lines 2-9).

Regarding claim 18, it is claim corresponding to claim 15 since the MAC address (Media Access Control Address), which is defined as a layer-2 address, is a unique identifier attached to most forms of networking equipment.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jung Park whose telephone number is 571-272-8565. The examiner can normally be reached on Mon-Fri during 7:10-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on 571-272-3126. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JP

Jung Park
Patent Examiner
Art Unit 2661
August 5, 2005

CHAU NGUYEN
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